

## **REMARKS/ARGUMENTS**

### **Drawing Objections**

The drawings were objected to for failing to depict each of the element of the claims. The applicant disagrees. Specifically, 37 CFR 1.83(a) states that the drawing must show "...every feature...in the claims.."

With respect to the Examiner's recitation of "a portion" (page 2, line 3), it is unclear what is meant. Clarification is respectfully required.

With respect to the "engaging element", the applicant points to hook 112 in Figure 1, which has corresponding description in the specification. Therefore, the objection is improper.

With respect to the "liquid retainer" and the "sound producer", the applicant points out that these elements are part of a listing in a Markush group, which specifies a portion in the head portion. As at least one element of the Markush group is present in the drawing (the engaging element), the requirements of 37 CFR 1.83(a) are fulfilled. Nevertheless, the applicant amended Figure 1 to include the "liquid retainer" and the "sound producer". As the "liquid retainer" and the "sound producer" are conventional features, they are represented with letters in a square box, which is further consistent with the requirements of 37 CFR 1.83(a). Corresponding description was added to the specification. A replacement page for the drawings is attached to this response. No new matter is added by virtue of the amendments.

### **Specification Objection**

The abstract was objected to for failing to fall within a range of having 50 to 150 words. The applicant respectfully disagrees and points out that the abstract has 57 words.

### **35 USC § 112**

**Claims 2 and 10** were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to indicate "...how the liquid retainer is fixedly coupled to the spiral-shaped tail..." The applicant respectfully disagrees for several reasons.

First, it is pointed out that claims 2 and 10 require that the *head portion* comprises the

liquid retainer and *not the spiral shaped tail*. Second, it is pointed out that claims 2 and 10 require that the head portion *comprises* the liquid container, whereas the Office argues that the liquid container is *fixedly coupled* to the tail.

Regardless of these issues, a 35 USC § 112, second paragraph rejection is improper as the use of the term "coupled" is a well recognized and definite term, which does not require further definition in the claims. The PTO collection of patents is replete with claims using that term. Should the office insist on the rejection, the applicant respectfully requests legal precedent for such action. Furthermore, and with respect to the depth of corresponding description, the applicant notes that coupling a liquid retainer (*e.g.*, a water filled balloon) to the head portion is well within the skill of a person of ordinary skill in the art, and therefore does not require detailed elaboration in the specification.

### **35 USC § 102(b)**

**Claims 1-16** were deemed to be anticipated by McAllister (U.S. Pat. No. 5,984,406), Star (U.S. Pat. No. 3,703,292), or Ming (U.S. Pat. No. 6,461,220). The applicant disagrees, especially in view of the amendments made herein. Still further, it is noted that the Office cited McAllister, however, failed to provide any reference to the national origin and patent number. Therefore, the applicant addresses only Ming and Star in the arguments below.

With respect to the toy of claims 1-16, the applicant points to the *express definition of the flying toy* in the specification beginning on page 3, line 26, which specifically "...exclude[s] toys of which at least one portion will remain held by a user..." For at least this reason, Starr is not a proper reference.

Still further, amended claim 1 expressly requires that the "...spiral-shaped tail comprises a material that maintains a spiral shape of the tail during flight when the toy is thrown into the air by a user..." The applicant *refers to the express definition* of the term "maintains the shape during flight" as given in the specification on page 5, beginning at line 14. Such behavior of the tail is clearly not taught or even suggested by Starr. On the contrary, if Starr's toy had resilient spiral, it would be *inoperable for it's intended purpose*. Clearly, Starr teaches against the claimed subject matter.

Similarly, Ming's toy fails to include a material that maintains a spiral shape of the tail during flight. This is clearly evidenced by Ming's Figure 8-5 to 8-8, in which the *tail undergoes substantial deformation* (see also "Brief Description" section and column 2). Once more, if Ming's toy was to include a relatively resilient spiral-shaped tail, the toy would be *inoperable for its intended purpose*. Moreover, with respect to the Examiner's rejection of claim 8, the applicant respectfully requests a basis for the official notice taken by the Office.

For at least these reasons, claims 1-16 should not be deemed anticipated by either Ming or Starr.

### 35 USC § 103

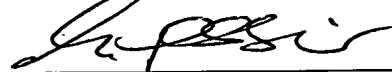
**Claims 9-16** were deemed to be obvious over Ming. Specifically, the Examiner is of the position that it would have been a mere design choice to provide instructions to the toy. The applicant respectfully disagrees.

As amended herein, claims 9-16 expressly require that the user is to propel the flying toy into the air *to impart rotation of the tail about the longitudinal axis during flight*. This is neither taught nor suggested. If anything, Ming's instructions would be directed to throw the toy against a wall to allow adhesion of the toy to the wall. However, this is entirely inconsistent with the presently claimed subject matter. Therefore, Ming teaches away from the claims as amended herein. Consequently, claims 9-16 should be held non-obvious over Ming.

In view of the present amendments and arguments, the applicant believes that all claims are now in condition for allowance. Therefore, the applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

~~RUTAN & TUCKER~~



Martin Fessenmaier, Ph.D.

Reg. No. 46,697

Tel.: (714) 641-5100